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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,335	09/25/2000	Randy D. Sines	CA67-006	3022

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EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/669,335

Applicant(s)

SINES ET AL.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5. 6) ☐ Other: _____

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, **as amended by any amendment specifically referred to in the oath or declaration.**

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, claims 1 is directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. "A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452. "A machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result." *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149

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F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998). Also see In re Johnston (CCPA) 183 USPQ 172. To overcome this rejection, the Examiner recommends that the Applicants incorporate technological limitations into the body of the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 4, 5, 8, 15, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claims 3, 4, and 5, these claims recite the limitation "said communicating step". It is unclear to the Examiner which "communicating step" of claim 2 is being referred to since claim 2 has two distinct communicating steps.

Referring to claims 8 and 21, these claims recite the limitation "approximately simultaneous". The term "approximately" is a relative term which renders the claim indefinite. This term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Referring to claim 15, this claim recites the limitation "said order information" in line 11. It is unclear to the Examiner whether this limitation refers to the "first portion" or "second portion" of the order information or both.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Franklin et al (US Patent 5,883,810) in view of Official Notice.

Franklin teaches a method for purchasing of goods or services and assuring payment over the internet, the purchase being made by a customer using a merchant, said merchant having an internet site at which the merchant offers goods or services; and wherein a bank authorizes the purchase and assures payment to the merchant (column 3, lines 34-47), comprising:

- obtaining order information indicating a customer desires to place an order which seeks to obtain goods or services using the merchant (column 8, lines 24-36; column 9, line 63 – column 10, line 5);
- delivering the order information to the merchant (column 10, lines 31-38);
- providing customer verification information to the bank (column 8, lines 43-65);
- accessing customer verification information by the bank, said customer verification information being previously set up with the bank (column 5, line 24 – column 8, line 13, lines 57-65);

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- verifying that the order information is associated with the customer using the customer verification information (column 10, line 61 – column 11, line 31);
- communicating from the bank to the merchant assurance of payment information upon successful verification in said verifying step (column 11, line 38-40);
- providing customer information to the bank in connection with said order information (column 8, lines 43-56);
- wherein the customer contacts the merchant internet site and builds an order file at least part of which is obtained by the bank in said obtaining computerized order information (column 8, line 24 – column 10, line 29).

Franklin does not teach providing delivery address information to the merchant from the bank in connection with said order. However, Franklin teaches that the bank has the customer's address in its database (Figure 4, item "80"), and that the bank communicates transaction information with the merchant (Figure 5). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the bank provide the customer's address (i.e. delivery address) to the merchant. One of ordinary skill in the art would have been motivated to do so in order to provide the merchant with all of the transaction information needed to complete the sale.

Franklin also does not teach communicating at least some of the order information from the bank to the merchant. However, Franklin teaches that the transaction number can contain order information (column 9, line 63 – column 10, line 5). Furthermore, Franklin

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teaches that this transaction number is communicated to the merchant (Figure 5).

Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, for the bank to communicate some of the order information to merchant. One of ordinary skill in the art would have been motivated to do so in order to verify the transaction details with the merchant. Franklin does not teach that the customer account verification information is supplied via a telephone line.

However, Official Notice is taken that it is old and well known in the art to provide customer account information via a telephone. One of ordinary skill in the art would have been motivated to do so in order to provide a customer with a more personalized way of providing sensitive information. Finally, Franklin does not explicitly teach a first portion or a second portion of the order information. However this limitation is inherent in the invention of Franklin. Franklin teaches that the customer, bank, and merchant all communicate with each other via the Internet (Figure 3). Furthermore, Franklin teaches that the customer communicates a transaction number to a merchant (first portion of the order information) (column 10, lines 24-41), and the bank communicates its own transaction number to the merchant (second portion of the order information) (Figure 5).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113.



Naeem Haq, Patent Examiner
Art unit 3625



WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

August 27, 2003